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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,368	01/14/2004	Secondo Dottori	247518US0CONT	2368
22850	7590	09/25/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SAUCIER, SANDRA E	
			ART UNIT 1651	PAPER NUMBER
			NOTIFICATION DATE 09/25/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/756,368	Applicant(s) DOTTORI ET AL.	
	Examiner Sandra Saucier	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 57-61 are pending and are considered on the merits.

Claim Rejections - 35 USC § 103

Claims 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweeney *et al.* [AW] in combination with US 5,747,536 [AA] and Ogawa *et al.* [U] and Tegos *et al.* [V].

The claims are directed to a method comprising: adding L-carnitine or an ester of carnitine to a platelet concentrate which has been leukodepleted and suspending the platelet concentrate in the mixture.

The intent of the claimed methods is the suppression of bacterial growth in the platelet concentrate.

Sweeney *et al.* disclose a method of adding L-carnitine or acetyl-carnitine (5mM) to platelet concentrates and agitating the mixture. This is said to reduce glycolysis in the platelet mixture.

Tegos *et al.* teach that glycolytic enzymes are present in isolated platelets.

Ogawa *et al.* teach the advantages of leukodepleting platelet products with regard to prevention of adverse reactions to PC transfusion.

US 5,747,536 discloses that esters of carnitine other than acetyl ester are known.

The primary reference lacks the disclosure of leukodepleting the platelet concentrate and use of the homologous derivatives of acetyl-carnitine.

The substitution of other esters of carnitine such as butyryl, valeryl, propionyl, isobutyryl for the acetyl ester of carnitine in the method of Sweeney *et al.* would have been obvious when US 5,747,536 was taken with Sweeney *et al.* because US 5,747,536 lists various esters of carnitine and also further discloses the addition of carnitine or its derivatives to platelet concentrates. In the absence of evidence to the contrary, the salts and esters of L-carnitine would reasonably be expected to have a similar activity to L-carnitine or acetylcarnitine because these are simple homologs which may be reasonably expected to have similar properties and activities in the

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absence of evidence to the contrary.

The substitution of a leukodepleted platelet concentrate for the platelet concentrate of the primary reference would have been obvious because both a nonleukodepleted platelet concentrate and a leukodepleted platelet concentrate comprise platelets, and platelets possess the glycolytic enzymes, see Tegos *et al.* which result in glycolysis during storage. Therefore, even if the leukocytes are removed for advantages known in the art, see Ogawa *et al.*, glycolysis in the preparation would still be expected to occur. Thus, the addition of L-carnitine, salts or esters thereof, to a leukodepleted platelet concentrate would be expected to reduce the glycolysis in the platelets and to maintain platelet quality as taught by Sweeney *et al.*

Although the applicant has recognized another advantage which would flow naturally from following the suggestions of the prior art, this fact cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Although the intent of applicant's method is different from the intent of the disclosed method, the one step of adding carnitine or an ester of carnitine in the same concentration is the same. Thus, the results of the method, suppression of bacterial growth, would reasonably be assumed to be the same as the result claimed.

It is not relevant to the analysis of the claimed method that the reference makes no mention of suppressing bacterial growth. Discovery of a new benefit for an old process does not render the old process patentable. *In re Woodruff*, 919 F. 2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Merely because the reference did not have one of applicant's purposes in mind when the (drug was administered) does not alter the drug's physiological activity. In the context of an anticipation rejection, the Federal Circuit stated, "Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the article's authors did not appreciate the results." *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F. 3d 1362, 1366, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999).

See also *In re Cruciferous Sprout* 64 USPQ2d 1202 Fed. Circuit.

One of ordinary skill in the art would have been motivated at the time

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of invention to make these substitutions in order to obtain the results as suggested by the references with a reasonable expectation of success. The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

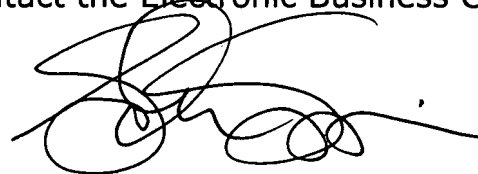
Conclusion

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is Monday through Friday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (571) 272-0922. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sandra Saucier
Primary Examiner
Art Unit 1651